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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,558	07/20/2004	Steven Lundberg	684001US10	4365

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EXAMINER

KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/710,558	Applicant(s) LUNDBERG, STEVEN	
	Examiner Vivek D. Koppikar	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1-24 have been examined in this application. This communication is the first action on the merits. The Information Disclosure Statement (IDS) statement filed on September 19, 2005 has also been acknowledged.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 14-24 are rejected under 35 U.S.C. 101 because even though the claims recite functionally descriptive material (e.g. billing steps/procedures) this material is not tangibly embodied. Specifically, it is not clear what the billing steps entail and if they involve the use of any structural components or if they are performed manually. As the claims are currently written the steps could be performed by humans without the aide of any structural components, devices or machines.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over “How to Control Your Company’s Legal Costs” by Harry J. Maue (hereinafter referred to as Maue) in view of US Patent Number 5,970,478 to Walker.

(A) As per claim 1, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to receive data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and to determine a separate charge in relation to each respective out-of-pocket cost wherein the charge is determined at least in part based on a cost associated with financing the out-of-pocket costs. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(B) As per claim 2, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to receive data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and to

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determine a separate charge in relation to each respective out-of-pocket cost wherein the charge is determined at least in part based on a cost associated with services related to a loan of funds to pay the out-of-pocket cost. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(C) As per claim 3, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to receive data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and to determine a separate charge in relation to each respective out-of-pocket cost wherein the charge is determined at least in part as a function of the cost of financing the out-of-pocket costs, the one or more computers further programmed to generate at least one client invoice including a billing for one of the out-of-pocket costs and a respective separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm,

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however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(D) As per claim 4, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to receive data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and to determine a separate charge in relation to each respective out-of-pocket cost wherein the charge is determined at least in part based on a cost associated with services related to a loan of funds to pay the out-of-pocket cost, the one or more computers further programmed to generate at least one client invoice including a billing for one of the out-of-pocket costs and a respective separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(E) As per claim 5, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln.

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56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to record data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and a corresponding plurality of separate charges in relation to each respective out-of-pocket cost wherein the charge is a function of the cost of financing the out-of-pocket costs. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(F) As per claim 6, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): Apparatus comprising one or more computers programmed to record data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and a corresponding plurality of separate charges in relation to each respective out-of-pocket cost wherein the charge is a function of the cost of financing the out-of-pocket costs, the one or more computers further programmed to record at least one client invoice including a billing for one of the out-of-pocket costs and a respective separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of

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calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(G) As per claim 7, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to receive data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and to determine a separate charge in relation to each respective out-of-pocket cost wherein the charge is determined at least in part as a function of the cost of financing the out-of-pocket costs, and further wherein the one or more computers are programmed to record a first data item corresponding to an amount owed by the law firm to a third party in regard to the separate charge and a second data item corresponding to an amount billed to a client in regard to the separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

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(H) As per claim 8, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to receive data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and to determine a separate charge in relation to each respective out-of-pocket cost wherein the charge is determined at least in part based on a cost associated with services related to a loan of funds to pay the out-of-pocket cost, and further wherein the one or more computers are programmed to record a first data item corresponding to an amount owed by the law firm to a third party in regard to the separate charge and a second data item corresponding to an amount billed to a client in regard to the separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(I) As per claim 9, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to receive data

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indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and to determine a separate charge in relation to each respective out-of-pocket cost wherein the charge is determined at least in part as a function of the cost of financing the out-of-pocket costs, the one or more computers further programmed to generate at least one client invoice including a billing for one of the out-of-pocket costs and a respective separate charge, and further wherein the one or more computers are programmed to record a first data item corresponding to an amount owed by the law firm to a third party in regard to the separate charge and a second data item corresponding to an amount billed to a client in regard to the separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(J) As per claim 10, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to receive data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and to determine a separate charge in relation to each respective out-of-pocket cost wherein the charge is determined at least in part based on a cost associated with services related to a loan of funds to

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pay the out-of-pocket cost, the one or more computers further programmed to generate at least one client invoice including a billing for one of the out-of-pocket costs and a respective separate charge, and further wherein the one or more computers are programmed to record a first data item corresponding to an amount owed by the law firm to a third party in regard to the separate charge and a second data item corresponding to an amount billed to a client in regard to the separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(K) As per claim 11, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to record data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and a corresponding plurality of separate charges in relation to each respective out-of-pocket cost wherein the charge is a function of the cost of financing the out-of-pocket costs and, further wherein the one or more computers are programmed to record a first data item corresponding to an amount owed by the law firm to a third party in regard to the separate charge and a second data item corresponding to an amount billed to a client in regard to the separate charge. At the

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time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(L) As per claim 12, Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computers programmed to record data indicative of a plurality of out-of-pocket costs for one or more clients of a law firm and a corresponding plurality of separate charges in relation to each respective out-of-pocket cost wherein the charge is a function of the cost of financing the out-of-pocket costs, the one or more computers further programmed to record at least one client invoice including a billing for one of the out-of-pocket costs and a respective separate charge, and further wherein the one or more computers are programmed to record a first data item corresponding to an amount owed by the law firm to a third party in regard to the separate charge and a second data item corresponding to an amount billed to a client in regard to the separate charge. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note:

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Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

(M) As per claims 13-24, these claims repeat features previously addressed in the rejection of claims 1-12, above, respectively, (they differ only in that they are directed to method claims rather than apparatus claims) and are, therefore, rejected on the same basis. (Note: The preamble of these claims recites a law firm accounting system which Maue and Walker do not explicitly disclose. However, the examiner take Official Notice with respect to this feature. At the time of the invention it would have been obvious for one of ordinary skill in the art to have modified the system of Maue in view Walker with the above feature with the motivation of providing a law firm with a means of tracking the costs that they had incurred for providing services to their clients and also, having a means of tracking costs they had incurred for financing these costs that they had incurred on behalf of their clients.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Numbers 6,070,150; 5,950,174; 5,649,117; 5,465,206, 5,794,221 and WO 96/10235 are all related to financing various expenses.

US Patent Number 5,466,919 teaches the concept of transferring funds for every transactions occurring on a customer's credit account (Col. 1. Ln. 15-23).

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Non-Patent Documents: "Owing Patients an explanation" and "Modern Healthcare" relate to out-of-pocket expenses which are incurred by professionals on behalf of clients.

7. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,


Vivek Koppikar

6/22/2006


C. LUKE GILLIGAN
PATENT EXAMINER